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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/720,042

Applicant(s)

BOND, EUGENE THOMAS

Examiner

Matthew D. Hoel

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 68-87,95 and 97-103 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 68-87,95 and 97-103 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 68 to 87, 95, and 97 to 103 are rejected under 35 U.S.C. 102(e) as being anticipated by Alcorn, et al. (U.S. patent 5,643,086 A).
3. As to Claim 68: '086 teaches a system for verifying at least one digital medium in a gaming machine (Abst.), said system comprising: an authentication agent, wherein said authentication agent is external to said gaming machine and further wherein said authentication agent (external gaming authority, 2:27-32, 3:13-21, 6:47-56): transmits a verification algorithm to said gaming machine; receives from said gaming machine an outcome of said verification algorithm; compares said received outcome with an expected outcome; and authenticates said gaming machine if said received outcome matches said expected outcome (Figs. 4 & 5; 3:35-55, 4:49-58, 8:38-52).
4. As to Claim 75: '086 teaches method for verifying at least one digital medium (Abst., Fig. 1) in a system including gaming machine and an external authentication agent (external gaming authority, 2:27-32, 3:13-21, 6:47-56), said method comprising:

transmitting a verification algorithm to said gaming machine from said external authentication agent to said gaming machine; deriving an outcome of said verification algorithm by execution thereof; comparing said derived outcome with an expected outcome; and authenticating said gaming machine if said derived outcome matches said expected outcome (play permitted if authenticated, Figs. 4 & 5). Receiving the outcome from the gaming machine is addressed in the rejection of Claim 68.

5. As to Claim 79: '086 teaches gaming device comprising: a gaming controller (Abst., Fig. 1); a data storage device storing data files and data corresponding to a valid verification signature (Fig. 2); an apparatus for loading data external from said gaming machine to said storage device, said apparatus transmitting an authentication agent (external gaming authority, 2:27-32, 3:13-21, 6:47-56); and a processor to process said authentication agent to derive a verification signature and compare said derived signature to said valid signature (Figs. 4 & 5).

6. As to Claim 80: '086 teaches method for presenting at least one game to a player at a gaming machine (Abst., Fig. 1; player permitted to play or not, Figs. 4 & 5), said method comprising: storing at least one of program code and program data in a digital medium (Figs. 1 & 2); transmitting via a communication link at least one of a program code or program file data and data corresponding to a verification algorithm to said gaming machine from an authentication agent (external gaming authority, 2:27-32, 3:13-21, 6:47-56); processing said verification algorithm to derive an outcome and comparing said outcome to one of an authorized outcome stored in said digital medium or transmitted with said algorithm and authorizing said transmitted program code or

program file data if said derived and stored outcomes compare (Figs. 4 & 5). Receiving the outcome from the gaming machine is addressed in the rejection of Claim 68.

7. As to Claim 95: '086 teaches a system for monitoring a gaming machine (Abst., Fig. 1), said system comprising: a regulating agent for monitoring at least a portion of said gaming machine, wherein said regulating agent generates a request for an authentication agent (external gaming authority, 2:27-32, 3:13-21, 6:47-56), and wherein said authentication agent is configured to: compare a received outcome from a verification algorithm at said gaming machine with an expected outcome; and authenticate said gaming machine if said received outcome matches said expected outcome (Figs. 4 & 5). Receiving the outcome from the gaming machine is addressed in the rejection of Claim 68.

8. As to Claim 69: '086 teaches the external agent prompting the gaming machine to request and execute said verification algorithm for said at least one digital medium and enrolls said gaming machine when said received outcome matches at least one of a set of predetermined criteria (game play permitted if match exists, Fig. 5, '086).

9. As to Claim 70: '086 teaches the request and execution of said verification algorithm being carried out based on at least one of a request of said gaming machine, a request of a player of said gaming machine, a request of an authorized agent, and upon a randomly or periodically scheduled event ('086, external gaming commission, 3:22-33).

10. As to Claim 71: '086 teaches a data structure configured to historically store said received outcome ('086, log of game play, credits, diagnostic information, 6:20-26).

11. As to Claim 72: '086 teaches the verification algorithm comprises the verification signature ('086, Figs. 4 & 5).
12. As to Claim 73: '086 teaches a processor configured to process said verification algorithm to determine at least one of corruption of said at least one digital medium and tampering with said at least one digital medium (unalterable ROM, authentication of Figs. 4 & 5 is thus checking for tampering, 2:35-41, '086).
13. As to Claim 74: '086 teaches the authorization agent is remote to said gaming machine and further comprising a communication link between said authorization agent and said gaming machine for transmission of said verification algorithm to said gaming machine ('086, 3:13-33).
14. As to Claim 76: '086 teaches prompting said gaming machine to request and execute said verification algorithm for said at least one digital medium and enrolling said gaming machine when said received outcome matches at least one of a set of predetermined criteria (game play permitted if match exists, Fig. 5, '086).
15. As to Claim 77: '086 teaches requesting and executing said verification algorithm based on at least one of a request of said gaming machine, a request of a player of said gaming machine, a request of an authorized agent, and upon a randomly or periodically scheduled event ('086, external gaming commission, 3:22-33).
16. As to Claim 78: '086 teaches storing any received outcome from a gaming machine for recollection thereof ('086, digests transmitted to gaming commission for audit purposes, 8:22-25,54-62).

17. As to Claim 81: '086 teaches that a player is unable to play said at least one game until receipt of said authentication result ('086, Abst.; 8:22-26).
18. As to Claim 82: '086 teaches comprising requesting said authentication result upon a player attempting to execute a game ('086, Fig. 5, 8:1-25, authorization routine called).
19. As to Claim 83: '086 teaches providing at least one of program code and program data as a game configured for downloading to said gaming machine, said gaming machine requesting said authentication result upon download of a game to said gaming machine ('086, authentication done when data downloaded to game device, 3:13-33; preparation phase, 2:42-57).
20. As to Claim 84: '086 teaches an agent external to said gaming machine triggering transmission of said verification algorithm data and at least one of a program code or program file data ('086, external gaming commission, 3:22-33).
21. As to Claim 85: '086 teaches registering said outcome for an audit ('086, 8:54-62).
22. As to Claim 86: '086 teaches transmitting said verification algorithm data as a verification signature ('086, Figs. 4 & 5).
23. As to Claim 87: '086 teaches processing said verification algorithm for identification of at least one of corruption of said at least one digital medium and tampering with said at least one digital medium (unalterable ROM, authentication of Figs. 4 & 5 is thus checking for tampering, 2:35-41, '086).

24. As to Claim 97: '086 teaches the regulating agent is an external agent located remotely from said gaming machine and remotely monitors at least a portion of said gaming machine ('086, remote verification by external agent, 3:13-33).
25. As to Claim 98: '086 teaches that the regulating agent monitors all of said gaming machine, and wherein said authentication agent verifies the integrity of said gaming machine ('086, 3:13-33).
26. As to Claim 99: '086 teaches the authentication agent being configured to verify that said gaming machine satisfies local gaming regulations ('086, gaming commission audits, 8:54-62).
27. As to Claim 100: '086 teaches that the regulating agent monitors software and peripheral devices of said gaming machine ('086, all memory devices in architecture checked, 3:55-67).
28. As to Claim 101: '086 teaches data being transferred if said received outcome matches said expected outcome ('086, 8:1-25, external gaming authority, 2:27-32, 3:13-21, 6:47-56).
29. As to Claim 102: '086 teaches that the verification algorithm detects tampering or rigging of software within said gaming machine ('086, 8:1-25).
30. As to Claim 103: '086 teaches that the authentication agent authenticates data stored on a digital medium in said gaming machine ('086, 8:1-25, Figs. 4 & 5).

Claim Rejections - 35 USC § 101

31. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

32. Claim 68 to 87, 95, and 97 to 103 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. According to page 10 of the recent Bilski decision, a claim must be tied to either a particular apparatus or there must be a transformation of matter from one form to another. Independent Claim 68 is a system, which could be software or an apparatus. Software should be cited as computer-executable instructions stored on a computer-readable medium, that when executed, cause the computer to execute the steps of a statutory processor or method, which process or method must still meet the Bilski criteria. Tying the claim to a particular apparatus can be done, for example, by citing how the specific structure of the apparatus carries out the specific steps of the method or process. The examiner will usually give suggestions such as accepting a wager from a player via a bill/coin slot or credit/debit card reader on a gaming device; accepting input from a player to play a game via an input device on the gaming device such as a slot handle, buttons, touchscreen, keyboard, mouse, joystick, or trackball; processing the input in physical memory via a physical processor according to the rules of the game; displaying the game outcome to the player via an output device on the gaming device such as a screen; and in the event of a winning outcome, remitting an award to the player via a bill/coin hopper or credit/debit card writer on the gaming device. In the case of Claim 68, citing an authentication agent in the form of computer-executable instructions stored

on a computer-readable medium, cause a processor of an external server to transmit the verification algorithm to the gaming machine, receive from the gaming machine an outcome of the verification algorithm, and execute the rest of the cited steps. The examiner suggest amending method Claim 75 to cite how the processor of the authentication agent controls the rest of the authentication agent computer's hardware to execute the steps of the method, such as outlined above. The examiner suggests amending Claim 79 to cite how the gaming device's processor controls the rest of the gaming devices hardware to execute the specific steps cited. Most of this claim's structure is cited as functionality, so it has similar considerations to a method claim. Claim 80 is a method claim and so has similar considerations as method Claim 75. Claim 95 as a method claim has similar considerations to method Claim 68. This action is non-final as the Bilski rejections were not necessitated by amendment for all claims.

Response to Arguments

33. Applicant's arguments filed 10-07-2008 have been fully considered but they are not persuasive. The examiner disagrees with the applicants and believes that '086 discloses transmitting a verification algorithm to the gaming machine and receiving the verification algorithm from the gaming machine. The applicants appear from their remarks to intend the examiner to interpret that structure such as ROM 29 of '086 Fig. 2 is stored and executed externally. The claims do not cite what the verification algorithm is. It could be a hash function ('086, Fig. 4, 41), an encryption program ('086, Fig. 4, 43), a decryption program ('086, Fig. 5, 33), or a message digest program ('086, 32, Fig.

3). The applicants have not amended around the structure of '086. '086 teaches that the gaming data and unique signature are stored externally (2:27-32). The game data set is only installed on the gaming machine after authentication (2:45-57), so if the gaming data set is stored externally it must receive a signal from the gaming machine before it is loaded onto the gaming machine. The decryption of '086 is done with a public key stored in ROM 29 on the gaming device (3:3-6). The game data set on the network is then installed (3:8-12). This will necessarily require a signal from the gaming machine. Quoting from 3:35-55: "From an apparatus standpoint, the first aspect of the invention comprises an electronic casino gaming system for providing authentication of a game data set of a casino type game prior to permitting game play, the system including first means for storing a casino game data set and a signature of the casino game data set, the signature comprising an encrypted version of a unique first abbreviated bit string computed from the casino game data set; second means for storing an authentication program capable of computing a second abbreviated bit string from the casino game data set stored in the first storing means and capable of decrypting the encrypted signature stored in the first storing means to recover the first abbreviated bit string; processing means for enabling the authentication program to compute an abbreviated bit string from the casino game data set stored in the first storing means and for enabling the authentication program to decrypt the encrypted signature; and means for comparing the computed second abbreviated bit string with the decrypted abbreviated bit string to determine whether a match is present. The first storing means preferably comprises a mass storage device, such as a disk drive unit, a

CD-ROM unit or a network storage unit. The second storing means preferably comprises an unalterable read only memory in which the authentication program is stored." The first storing means corresponds to the mass storage unit, and the second storage means corresponds to ROM 29 of '086. The authentication can be conducted locally or externally via a network (4:49-58). This external authentication is used to authenticate ROM 29 in the same manner as ROM 29 authenticates the mass storage unit and the rest of the contents of the gaming machine (8:38-52); in this case the authentication program would necessarily be external to the gaming machine. This can be done for example, by the gaming commission (8:54-62), so the gaming machine would receive an verification algorithm from the external source and send it back to the external authentication agent (9:47-58). The examiner respectfully disagrees with the applicants as to the claims' condition for allowance.

Conclusion

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.
35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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